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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,817	02/22/2002	Takashi Nakabayashi	033035.088	5522

7590 05/20/2004  
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EXAMINER

NGUYEN, DUNG T

ART UNIT PAPER NUMBER

2828

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/079,817

Applicant(s)

NAKABAYASHI ET AL.

Examiner

Dung (Michael) T Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuhara et al (US patent 5,787,215).

With respect to claim 1, Kuhara et al disclose a semiconductor light emitting device (70), a monitoring light receiving element (85) provided so as to be optically coupled to said semiconductor light emitting device, a package (160) is consider as a housing containing said semiconductor light emitting device, driving element and monitor light receiving element, the package can include the driving circuit of the laser, col. 29 line 56 to col. 36 line 35, see figures 23-24 and 42.

With respect to claims 2-3, Kuhara et al show in figures 10-23 and 41-42, a first mounting member having first, second and third region, a third region and first region having a support surface, the monitor light receiving element (85) is

provided on said support surface and includes a light detecting region for detecting light, a semiconductor light emitting device (70) is provided on said first region of said first mounting member, wherein said semiconductor light emitting device has a pair of end surfaces and an active layer, not col. 21 line 25 to col. 36 line 67.

With respect to claims 4-8, Kuhara et al disclose a housing (160) has a plurality of side walls, a monitoring light receiving element (85), a substrate (162), wherein said substrate has transmission lines for transmitting modulation signals to said driving element and transmission line being connected electrically to said driving element, see figures 23-24 and 41-42.

With respect to claims 9-14, Kuhara et al disclose an optical fiber (178) having an end (180) coupled optically to said semiconductor light emitting device, and semiconductor light emitting device includes an optical integrated laser element, said optical integrated laser element including an optical modulator and a semiconductor laser (29), note col. 4 line 3 to col. 36 line 67, see figs. 6, 10-15, 23 and 41-42.

With respect to claims 15-20, Kuhara et al disclose a housing (160), a laser diode (70) includes a substrate (71) and a monitor element (85) has a substrate (86), laser diode and monitor element having the wirings (192-195) for transmitting modulation signals, a wall portion having said plurality of lead terminals (174-176), see figures 13-24.

### *Response to Arguments*

Applicant's arguments filed on 02/09/04 have been fully considered but they are not persuasive.

Applicant argues that the Kuhara reference fails to teach or suggest the sequential region arrangement of the light emitting device, the driving element, and the monitoring light receiving element. The examiner does not concur because the Kuhara reference clearly suggested in Fig.42A a light emitting device 325 located in the first region, the monitoring light receiving element 264 in the third region, and the driving element (col.29, 1.56-59). Even though, the Kuhara reference does not disclose the specific driving element region, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place the driving element in the second region (between the light emitting device and the monitoring light receiving element).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

### **Communication Information**

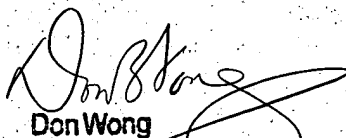
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung (Michael) T Nguyen whose telephone number is (571) 272-1949. The examiner can normally be reached on 8:30 - 17:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-3329.

Michael Dung Nguyen

  
Don Wong  
Supervisory Patent Examiner  
Technology Center 2800